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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/750,046   | 12/29/2000  | Masahiro Yoshiasa    | 074273/0178         | 6705             |
| 22428  | 7590        | 04/06/2005           | EXAMINER            |                  |
| FOLEY AND LARDNER<br>SUITE 500<br>3000 K STREET NW<br>WASHINGTON, DC 20007 |             |                      | PARTON, KEVIN S     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2153                |                  |
| DATE MAILED: 04/06/2005  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/750,046

Applicant(s)

YOSHIASA, MASAHIRO

Examiner

Kevin Parton

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-11,13-16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,13-16 and 18-23 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1, 8, 10, and 14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Specification***

2. Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The entire text of claim 9 is included in newly amended claim 8 so claim 9 does not further limit its parent claim.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 2, 15, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Regarding claims 2, 15, and 22, the abbreviation "PHS" should be fully defined in its first instance in the claim tree.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2153

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 5-11, 13-16, and 18-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Yu et al. (USPN 6,684,087), hereinafter referred to as Yu.

8. Regarding claim 1, Yu teaches a gateway server system comprising:

- a. A convert section converting a first contents into second contents, wherein said first contents is received from a contents server in response to a request of a small terminal and said second contents corresponds to a display performance of a display section of said small terminal (column 6, lines 56-58; column 7, lines 8-16).
- b. Wherein the convert section judges whether said first contents is a picture contents, and when said first contents is not said picture contents, said convert section does not convert said first contents into said second contents and in that case the gateway server provides the first contents to the small terminal in an unconverted format (column 6, lines 56-67; column 7, lines 8-16). Note that information such as authentication and other text is not converted, only images are converted by the gateway.
- c. An output section outputting said second contents to said small terminal (column 9, lines 10-11).

9. Regarding claims 2, 15, and 22, Yu teaches all the limitations as applied to claims 1, 14, and 8, respectively. He further teaches means wherein the small terminal is one of a portable wireless telephone, a PHS terminal, and a personal digital assistant (column 3, lines 55-60).

10. Regarding claims 3 and 16, Yu teaches all the limitations as applied to claims 1 and 14, respectively. He further teaches means wherein said second contents can be displayed in said display section (column 7, lines 24-25).

11. Regarding claims 5 and 18, Yu teaches all the limitations as applied to claims 1 and 14, respectively. He further teaches means wherein said convert section does not convert said first contents into said second contents, when said first contents is received from said contents server in response to a request of a non-small terminal other than said small terminal, and wherein said output section outputs said first contents to said non-small terminal (column 6, lines 55-67; figure 4). Note that the account information could be for a full size mobile terminal in which case, no conversion would be done.

12. Regarding claims 6 and 19, Yu teaches all the limitations as applied to claims 1 and 14, respectively. He further teaches means wherein said display performance corresponds to the number of display pixels of said display section (figure 4).

13. Regarding claims 7 and 20, Yu teaches all the limitations as applied to claims 1 and 14, respectively. He further teaches means wherein said display performance corresponds to the number of display colors of said display section (figure 4). Please note that color is one of a number of attributes that may be used.

14. Regarding claim 8, Yu teaches a contents obtaining system comprising:

- a. A terminal having a display section to display contents (figure 2).
- b. A contents server storing contents (figure 1, element 104).
- c. A gateway server arbitrating a communication between said terminal and said contents server (figure 1, element 114; column 4, lines 7-12).
- d. Wherein said terminal outputs a first request for obtaining required contents to said gateway server (figure 6A, element 604).
- e. Wherein said gateway server outputs a second request for obtaining said required contents to said contents server in response to said first request (figure 6B, element 646; column 8, lines 45-47).
- f. Wherein said contents server outputs said required contents to said gateway server in response to said second request (column 8, lines 45-48).
- g. When said required contents are picture contents said gateway server converts said required contents into a specific contents, wherein said specific contents correspond to a display performance of said display section of said terminal (column 6, lines 56-58; column 7, lines 8-16)
- h. Wherein said gateway server outputs said specific contents to said terminal (column 9, lines 10-11)
- i. Wherein the gateway server judges whether the required contents are picture contents (column 6, lines 56-67; column 7, lines 8-16). Note that information such as authentication and other text is not converted, only images are converted by the gateway.

- j. When the required contents is not the picture contents, the gateway server does not convert the required contents into the specific contents and also does not convert the required contents in any manner, and the gateway server outputs the required contents instead of the specific contents to the terminal (column 6, lines 56-67; column 7, lines 8-16).

15. Claim 9 is rejected for the same reasons shown with regard to claim 8.

16. Regarding claim 10, Yu teaches all the limitations as applied to claim 8. He further teaches means wherein said terminal is one of a small terminal and a terminal other than a small terminal, and wherein when said terminal is a small terminal, said terminal outputs said first request for obtaining said required contents to said gateways server, said first request including a information indicating that said terminal is a small terminal, and wherein when said gateway server does not receive said information, said gateway server does not convert said required contents into said specific contents and when the terminal is the small terminal, the gateway server converts the required contents into first specific contents and when the terminal is the terminal other than then small terminal, the gateway server converts the required contents into second specific contents different from the first specific contents (column 6, lines 30-35, 56-67; column 7, lines 8-16; column 8, lines 45-50). Note that the requesting device may be anonymous, in which case, the server would not alter the content. Also, devices with different capabilities can access the server and it will produce different content catered to the device.

17. Regarding claim 11, Yu teaches a contents obtaining system with means for:
- a. Outputting a first request for obtaining a contents from a terminal to a gateway server (figure 6A, element 604).
  - b. Outputting a second request of obtaining said contents from said gateway server to a contents server in response to said first request (figure 6B, element 646; column 8, lines 45-47).
  - c. Outputting said contents from said contents server to said gateway server in response to said second request (column 8, lines 45-48)
  - d. Converting said contents into a specific contents in said gateway server, wherein said specific contents corresponds to a display performance of a display section of said terminal (column 6, lines 56-58; column 7, lines 8-16).
  - e. Outputting said specific contents to said terminal from said gateway server (column 9, lines 10-11).
  - f. Determining whether said contents are picture contents, and wherein when the contents are not determined as picture contents in step (f), step (d) is not performed and step (e) includes outputting said contents, instead of said specific contents, in an unconverted format, to said terminal from the gateway server (column 6, lines 56-67; column 7, lines 8-16).
18. Claim 13 is rejected for the same reasons shown above regarding claim 10.
19. Claim 14 is rejected for the same reasons shown above regarding claim 1.



20. Regarding claim 21, Yu teaches all the limitations as applied to claim 1. He further teaches means wherein when said first contents are received from the content server in response to a request from a non-small terminal, the convert section does not convert said first contents into said second contents, and the output section outputs the first contents to the non-small terminal (column 6, lines 56-67; column 7, lines 8-16). Note that any size terminal can request information and if it's a regular sized terminal, it would not require conversion.

21. Regarding claim 23, Yu teaches all the limitations as applied to claim 10. He further teaches means wherein the first specific contents correspond to picture contents to suit a particular display of the small terminal, and wherein the second specific contents correspond to picture contents to suit a particular display of the terminal other than the small terminal (column 6, lines 30-35, 56-67; column 7, lines 8-16; column 8, lines 45-50).

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (571)272-3958. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin Parton  
Examiner  
Art Unit 2153

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